

## **C. APPLICANT'S COMMENTS**

### ***i. Overview***

Claims 19, 20 have been allowed, with Claims 21, 22 being added and Claims 1-17 being canceled without prejudice. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Favorable consideration of Claims 21, 22 is respectfully requested.

### ***ii. Added Claim 21***

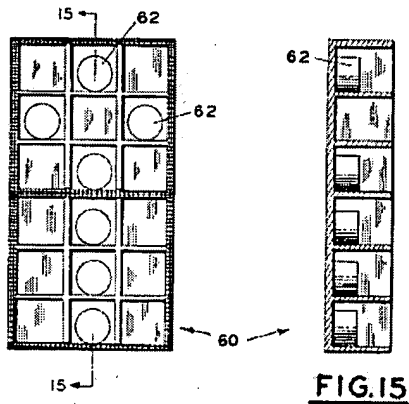
Added Claim 21 has the same limitations as allowed Claim 19 except with the removal of the handle and the indicia features. Independent Claim 21 is respectfully submitted to be in condition for allowance as none of the prior art references cited teach or suggest all of the features of the added Claim 21.

### ***iii. Added Claim 22***

Added Claim 22 is a method claim which claims the process of setting up the invention and then utilizing the invention for practicing hockey shooting. None of the prior art references cited teach the method of practicing hockey shooting as claimed within independent Claim 22. Below is a brief discussion of each of the prior art references cited with respect to original Claims 1-18 (now canceled).

### ***iv. Prior Art References***

**Faudree** (U.S. Patent No. 3,061,947) merely teaches an "apparatus for teaching and learning basic arithmetic". Faudree is not even related to nor is it capable of being utilized for practicing hockey shooting, particularly as claimed in independent Claim 22. Figures 14 and 15 of Faudree clearly show that the "compartments" within Faudree do not allow for the passage of the object (62) if they were engaged by an object. Faudree provides no support nor suggestion for providing a hockey practice shooting device and method as claimed within the present application.

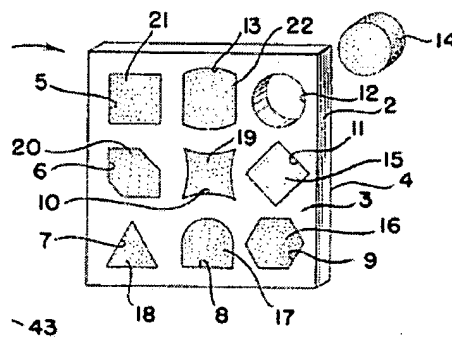


**FIG. 14**

**FIG. 15**

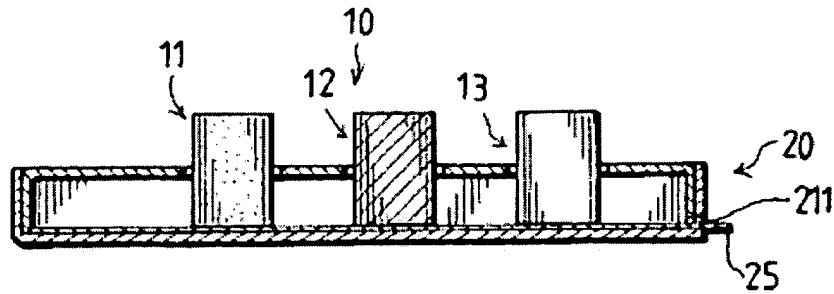
**Faudree (U.S. Patent No. 3,061,947)**

**Studen** (U.S. Patent No. 3,280,499) merely teaches an “expanded plastic board having apertures retaining punched pieces”. Studen is designed for educational purposes and does not teach nor suggest a hockey practice shooting device and method as claimed within independent Claim 22.



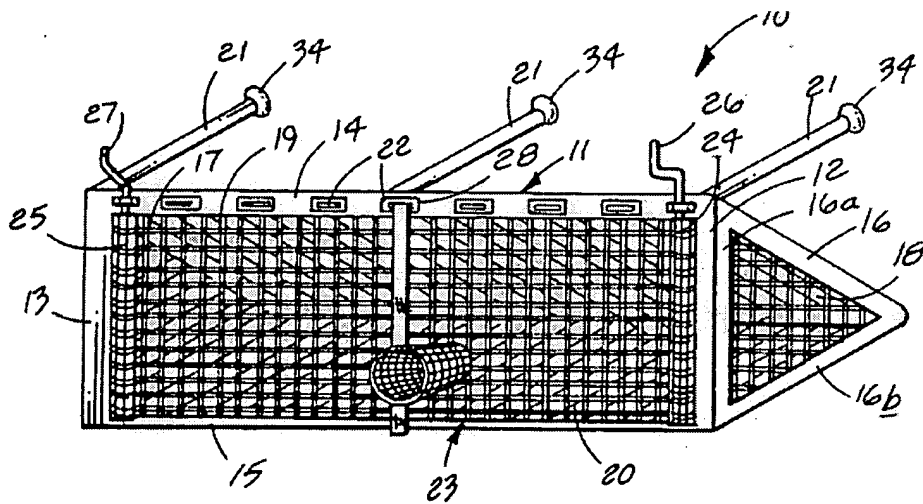
**Studen (U.S. Patent No. 3,280,499)**

**Kao** (U.S. Patent No. 5,752,701) merely teaches a “game device” that has a plurality of recessed portions in a board that receive various shaped objects but does not allow for the pass through of the objects. Kao is designed for different purposes and does not teach nor suggest a hockey practice shooting device and method as claimed within independent Claim 22.



Kao (U.S. Patent No. 5,752,701)

**Borazjani** (U.S. Patent No. 5,000,461) teaches a “portable soccer goal apparatus” that has a “target cup” for the shooter to aim at. However, Borazjani does not teach the usage of targets within a plurality of openings nor the process of engaging the targets for practicing as disclosed in the present application and claimed in independent Claim 22.



In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). “To support the conclusion that the claimed invention is directed to obvious subject matter,

either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

"To establish a prima facie case of obviousness, three basic criteria must be met." MPEP §706.02(j). First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

*In re Fritch*, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

*Ex parte Gerlach and Woerner*, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

First, there is **no suggestion or motivation** in the cited references or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Borazjani is the only cited patent reference that relates to a shooting aid for sports, but it is limited to soccer and also does not disclose nor suggest the structure and functionality of the present invention as discussed previously. The other cited references are limited to "educational" devices and other arts not related to hockey practice.

Second, there **no reasonable expectation of success** to combine the cited prior art references. Finally, the prior art references even when combined do **not teach or suggest all the claim limitations** in independent Claim 22 (or independent Claim 21).

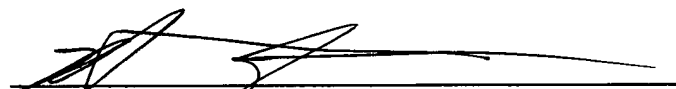
For these reasons, among others, the combination of the prior art references cited in the first Office Action cannot suggest the combination of features in applicant's

Claims 21, 22, and it is therefore submitted that any potential rejection against these claims should be reconsidered and Claims 21, 22 allowed.

**D. CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



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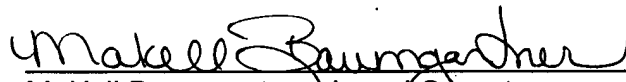
Attorney's Docket No. WITZ-001

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**Alexandria, VA 22313-1450**

on December 7, 2004.

  
MaKell Baumgartner, Legal Secretary

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